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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/416,165 10/11/99 KANATZIDIS

M 6550-000022

IM22/0301
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EXAMINER

KOSLOW, C

ART UNIT

PAPER NUMBER

1755
DATE MAILED:

03/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/416,165

Applicant(s)

KANATZIDIS ET AL.

Examiner

C. Melissa Koslow

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6-12 and 14-46 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

This action is in response to applicants' amendment of 7 February 2001. The art rejections and the 35 USC 112 rejection are withdrawn due to the amendment to the claims. The objection over page 3, line 6 is withdrawn due to the amendment to the specification. The 35 USC 112 first paragraph rejection is withdrawn due to applicants' arguments. Applicant's arguments with respect to the remaining objections have been fully considered but they are not persuasive.

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application in the first sentence of the specification (37 CFR 1.78).

Applicants argue 37 CFR 1.48(a) does not require a specific reference to provisional applications in the first sentence of the specification to benefit from the provisional application. This is incorrect. 37 CFR 1.78(a)(4) clearly states an application in which the benefits of an earlier provisional application are desired must contain a specific reference to the prior application in the first sentence of the specification. This is also taught in 35 USC 119(e)(1).

This application is in condition for allowance except for the following formal matters:

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Applicants' comments with respect to the oath are acknowledged.

The disclosure is objected to because of the following informalities: On page 3, lines 36, on page 9, lines 17-19 and line 2 of the insert for page 3, lines 2-17; the phrase "selected from the group consisting essentially of" should be "selected from the group consisting of". This change is necessary since "selected from the group consisting essentially of" is improper Markush terminology. The correct phrasing for a Markush format grouping is "selected from the group consisting of". Applicants are referred to MPEP 2173.05(h), which teaches the accepted format for Markush format definitions. In addition, this change is necessary so the wording of the definitions of A, X and D in the specification corresponds with the wording of the definitions for A, X and D in the claims. Appropriate correction is required.

Applicants argue "consisting essentially of" is a properly used phrase. Applicants are incorrect. This is an improper phrase when used in Markush format definition. The Examiner did not provide a reason for the above changes since the requirements for Markush language format are expected to be well known in U.S. Patent practice and the fact it is clear that wording of the claims and the specification do not correspond.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (703) 308-3817. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (703) 308-3823.

The fax number for Amendments filed under 37 CFR 1.116 or After Final communications is (703) 872-9311. The fax number for all other official communications is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661 or (703) 308-0662.

cmk
February 28, 2001



C. Melissa Koslow
Primary Examiner
Tech. Center 1700